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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,086	07/22/2005	Leopold Murhammer	449122082300	5609

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EXAMINER

BRANDT, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/543,086

Applicant(s)

MURHAMMER ET AL.

Examiner

Christopher M. Brandt

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed on October 20, 2006. **Claims 1-11** are still pending in the present application.

Response to Arguments

Applicant's arguments, see pages 5-7 of Remarks, filed October 20, 2006, with respect to the rejection(s) of **claim(s) 1-2, 5-11** under 35 U.S.C. 102(b) and **claims 3-4** under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **Nieminen et al.** and **Lu et al.** (**claims 1-2, 5-11**) and further in view of **Helferich** (**claims 3-4**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2617

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Nieminen at al. (WO 02/084985 A1)**, and further in view of **Lu et al. (US PG PUB 2002/0009991)**.

Consider **claim 1**. Eloranta discloses a method for deciding whether to intercept a telecommunications connection, comprising:

for an identification detail relating to at least one subscriber of the telecommunications connection, checking whether the identification detail is included in at least one identification relating to the subscriber to be monitored which is stored in a list; and

intercepting the telecommunication connection if it is stored in the list (page 5 line 27 – page 6 line 19, page 7 lines 26-27, read as a method for monitoring (intercepting) the communications of a certain equipment or person, wherein for an identification information (preferably MSISDN, IMEI, IMSI) relating to at least one mobile station 1 (figure 1) a check is made for matching entry of identification information, which is stored in database 5 (figure 1) with interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to the subscriber.

However, Nieminen et al. (hereinafter Nieminen) discloses identification detail is associated with at least one identification detail **abbreviation** relating to the subscriber (Nieminen; page 6 lines 10-17, page 7 lines 5-27, read as thus the expression “+35840” specifies a group of number all of which begin +35840, such as +3584012345 and +3584098765. This is referred to as using wildcards (abbreviations)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Nieminen into the method of Eloranta in order to reduce the required time for routing and space in the address database (Nieminen; page 7 lines 6-12).

Although, the combination of Eloranta and Nieminen suggests the **abbreviation** of a subscribers' identification, they fail to explicitly define the wildcard as an **abbreviation**.

However, Lu et al. (hereinafter Lu) disclose an **abbreviation** of a subscribers' identification (Lu; paragraph 171, read as The IMSI or optionally some abbreviated version of the IMSI may be used to uniquely identify a record in the registry).

Therefore, it would have been obvious to one of ordinary skill in the art to have incorporated the teachings of Lu into the methods of Eloranta and Nieminen in order to recognize MS units that are authorized to use resources (Lu; paragraph 171).

Consider **claim 11**. Eloranta discloses a device for deciding whether to intercept telecommunications connections, comprising:

Art Unit: 2617

a list of identification detail relating to telecommunications subscribers to be intercepted stored in a memory;

comparison equipment for comparing identification details transferred over a telecommunications connection relating to subscribers of the telecommunications connection with stored identification detail; and

decision equipment to initiate the monitoring of a telecommunications connection with at least one telecommunications subscriber identified as to be monitored by an identification detail (page 5 line 27 – page 6 line 19, read as a legal interception gateway (LIG) 3 (figure 1) to monitor (intercept) communication connections, with an identifier data relating to a mobile station (figure 1) to be monitored (intercepted) stored in database 5 (figure 1), with matching entry means in the database 5 for identification information cooperates over a communication connection relating to a mobile station 1 with stored identification information, with the legal interception gateway (LIG) 3 to initiate the interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to the subscriber.

However, Nieminen et al. (hereinafter Nieminen) discloses identification detail is associated with at least one identification detail **abbreviation** relating to the subscriber (Nieminen; page 6 lines 10-17, page 7 lines 5-27, read as thus the expression “+35840” specifies a group of number all of which begin +35840, such as +3584012345 and +3584098765. This is referred to as using wildcards (abbreviations)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Nieminen into the device of Eloranta in order to reduce the required time for routing and space in the address database (Nieminen; page 7 lines 6-12).

Although, the combination of Eloranta and Nieminen suggests the **abbreviation** of a subscribers' identification, they fail to explicitly define the wildcard as an **abbreviation**.

However, Lu et al. (hereinafter Lu) disclose an **abbreviation** of a subscribers' identification (Lu; paragraph 171, read as The IMSI or optionally some abbreviated version of the IMSI may be used to uniquely identify a record in the registry).

Therefore, it would have been obvious to one of ordinary skill in the art to have incorporated the teachings of Lu into the devices of Eloranta and Nieminen in order to recognize MS units that are authorized to use resources (Lu; paragraph 171).

Consider **claim 2** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein the identification detail abbreviation is part of an identification detail relating to a mobile subscriber number (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-37, Nieminen; page 6 lines 10-17, page 7 lines 5-27, Lu; paragraph 171).

Consider **claim 5** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein the identification detail abbreviation is part of a telecommunications terminal identification (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-37, Nieminen; page 6 lines 10-17, page 7 lines 5-27, Lu; paragraph 171).

Consider **claim 6** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein the telecommunications connection is routed over a mobile radio network and/or fixed network and/or the Internet (Eloranta; page 5 lines 10-25).

Consider **claim 7** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein the checking is undertaken by equipment of a telecommunications network over which the telecommunications connection is routed or by equipment connected to it (Eloranta; pages 6 lines 8-19).

Consider **claim 8** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein the interception is undertaken by official equipment (Eloranta; page 5 lines 27 – page 6 line 6).

Consider **claim 9** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein identification details are checked when a connection is set up (Eloranta; page 6 lines 8-19).

Consider **claim 10** and **as applied to claim 1**. Eloranta, Nieminen, and Lu disclose a method wherein identification details of telecommunications subscribers are checked on transmission of data packets over a telecommunications connection (Eloranta; page 5 lines 10-25).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Nieminen et al. (WO 02/084985 A1)**, in view of **Lu et al. (US PG PUB 2002/0009991)** and further in view of **Helferich (US Patent 6,826,407)**.

Consider **claim 3** and as **applied to claim 1**. Eloranta, Nieminen, and Lu disclose the claimed invention except wherein the identification detail abbreviation is part of an e-mail address.

However, Helferich discloses a method wherein an identification detail abbreviation is part of an e-mail address of a telecommunications subscriber (abstract, column 9 lines 34-49, read as the replay address may be an e-mail address or an abbreviated e-mail address that is associated with an e-mail address stored at the IMG 150. It is also noted from the abstract that this invention does in fact relate to a mobile communication device for receiving visual messages (e-mails)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Helferich into the methods of Eloranta, Nieminen, and Lu in order to be able to monitor all possible transmissions of information.

Consider **claim 4** and as **applied to claim 3**. Eloranta, Nieminen, and Lu, and Helferich disclose a method wherein the identification detail abbreviation is a domain name or a part of a domain name in an e-mail address of a telecommunications subscriber (Helferich; column 9 lines 34-49).

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Brandt whose telephone number is (571) 270-1098. The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.



Christopher M. Brandt

C.M.B./cmb

November 17, 2006



NICK CORSARO
SUPERVISORY PATENT EXAMINER
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